



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------------------|-----------------------------|
| 10/761,361 | 01/22/2004 | Akihito Ogawa | 247945US2S | 3268 |
| 22850 | 7590 | 05/24/2007 | | |
| OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314 | | | EXAMINER DINH, TAN X | |
| | | | ART UNIT 2627 | PAPER NUMBER |
| | | | NOTIFICATION DATE 05/24/2007 | DELIVERY MODE ELECTRONIC |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentdocket@oblon.com
oblonpat@oblon.com
jgardner@oblon.com

Office Action Summary

Application No.

10/761,361

Applicant(s)

OGAWA ET AL.

Examiner

TAN X. DINH

Art Unit

2627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 April 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) 1-3, 5, 7 and 8 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 4 and 6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

1) Applicant's election with traverse of Species C (*claims 4 and 6*) in the reply filed on **4/24/2007** is acknowledged. The traversal is on the ground(s) that to examine entire application would not place a serious burden on the examiner. This is not found persuasive because:

The search and examine entire application is a serious burden to examiner since the search would cover 4 distinct species (*a, b, c and d*) and the prior art applicable to one species may not applicable to other species. In another words, the *search and examine entire application* would be *four times to process a single invention*.

The requirement is still deemed proper and is therefore made FINAL.

Claims *1-3,5,7 and 8* are withdrawn from further consideration by the examiner.

2) The I.D.S filed **4/16/2004, 6/16/2004, 11/02/2005 and 4/24/2007** have been considered by the Examiner. However, the Japan and/or foreign document(s), if they have not been written in English, are considered to the extent that could be understood from the English Abstract and the drawings.

Form **PTO-1449** or **PTO/SB/08** is(are) attached herein.

3) The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to

Art Unit: 2627

which the claims are directed. The following title is suggested:

**OPTICAL RECORDING MEDIUM HAVING RELATION BETWEEN WOBBLE
AMPLITUDE AND REPRODUCTION SIGNALS.**

4) Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

5) Claims 4 and 6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The phrase " or less " (claim 4, line 12) render(s) the claim(s) indefinite since the signal amplitude could be at zero which is impossible for operating the recording device (the lowest signal amplitude in this case is 1.6%). The resulting claim(s) do not clearly set forth the metes and bounds of the patent protection desired.

The phrase " or more " (claim 6, line 12) render(s) the claim(s) indefinite since the signal amplitude could go up more than 9%, which is impossible for operating the recording device.

6) The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the

Art Unit: 2627

differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7) This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8) Claims 4 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over KURIBAYASHI (6,434,091).

KURIBAYASHI discloses an information recording medium as claimed in claim 4, comprising a guide groove along which information is recorded in an information recording region, the information being formed as a recorded mark in both of concave and convex portions of the guide groove, management information including address information being recorded by a wobble of the guide groove (figure 1, optical disc 1, figure 2, guide groove 5,

land 7 and wobble 6), *except to specifically show that the signal amplitude by the wobble of the guide groove is 9% or less of a maximum amplitude of a signal produced at the time of when the light beam crosses the guide groove. However, in column 19, lines 14-38, KURIBAYASHI suggests that the signal amplitude by the wobble of the guide groove is several% of a maximum amplitude of a signal produced at the time of when the light beam crosses the guide groove (maximum amplitude at the time of light beam crosses track pitch). Therefore, one of ordinary skill in the art at the time of the invention was made would have been motivated to make the signal amplitude by the wobble of the guide groove about 9% or less as claimed.*

KURIBAYASHI discloses an information recording medium as claimed in claim 6, comprising a guide groove along which information is recorded in an information recording region, the information being formed as a recorded mark in both of concave and convex portions of the guide groove, management information including address information being recorded by a wobble of the guide groove (figure 1, optical disc 1, figure 2, guide groove 5, land 7 and wobble 6), *except to specifically show that the signal amplitude by the wobble of the guide groove is 1.6% or more of a maximum amplitude of a signal produced at the time of when the light*

Art Unit: 2627

beam crosses the guide groove. However, in *column 19, lines 14-38*, KURIBAYASHI suggests that the signal amplitude by the wobble of the guide groove is **several %** of a maximum amplitude of a signal produced at the time of when the light beam crosses the guide groove (maximum amplitude at the time of light beam crosses track pitch). Therefore, one of ordinary skill in the art at the time of the invention was made would have been motivated to make the signal amplitude by the wobble of the guide groove about 1.6% or more as claimed.

9) The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Applicant is reminded that in amending in response to a rejection of claims (if the rejection involves with any applicable arts), the patentable novelty must be clearly shown in view of the state of the art disclosed by the references cited and the objection made. Applicant must also show how the amendments avoid such references and objections. See 37 CFR § 1.111(c).


Form PTO-892 is attached herein.

10) Any inquiry concerning this communication or earlier communications from the examiner should be directed to **TAN XUAN DINH** whose telephone number is (571)272-7586. The examiner can normally be reached on **MONDAY to FRIDAY** from **9:00AM to 5:00PM**.

Art Unit: 2627

The fax phone number for the organization where this application or proceeding is assigned is **571-273-8300**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either **Private PAIR** or **Public PAIR**. Status information for unpublished applications is available through **Private PAIR** only. For more information about the PAIR system, see <http://pair-direct.uspto.gov/>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at **866-217-9197** (toll-free).



TAN DINH
PRIMARY EXAMINER
May 21, 2007